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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,419	02/07/2002	Darren Dofher	TERA P2311 PTUS	1711

7590 07/23/2003

Paul V. Storm
STORM & HEMINGWAY, L.L.P.
Ste. 460
8117 Preston Rd.
Dallas, TX 75225

EXAMINER

SALDANO, LISA M

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,419

Applicant(s)

DOFHER, DARREN

Examiner

Lisa M. Saldano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 7, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-36, drawn to a method for installing a subsurface fiber optic cable system, classified in class 405, subclass 183.4.
 - II. Claims 37-40, drawn to a cable winder, classified in class 242, subclass 388.
 - III. Claims 41-43, drawn to a fiber optic cable, classified in class 385, subclass 100.
 - IV. Claims 44-46, drawn to a junction box, classified in class 439, subclass 535.
 - V. Claims 47-51, drawn to a method for installing a subsurface fiber optic cable with semi-rigid member, classified in class 405, subclass 184.4.
 - VI. Claims 52-58, drawn to a fiber optic protector, classified in class 385, subclass 135.
 - VII. Claims 59-60, drawn to a fiber optic cable network, classified in class 370, subclass 404.
 - VIII. Claims 61-64, drawn to a portion of a fiber optic cable network, classified in class 370, subclass 400.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

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does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method for installing a subsurface fiber optic cable system as claimed does not require a cable winder with a frame attached to a base. The subcombination has separate utility such as a cable winder for cable other than the cable of a fiber optic system.

3. Inventions of Groups I and III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method for installing a subsurface fiber optic cable system as claimed does not require a fiber optic cable with moisture absorbent member and an outer casing. The subcombination has separate utility such as a fiber optic cable for above surface installation.

4. Inventions of Groups I and IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method for installing a subsurface fiber optic cable system as claimed

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does not require a junction box with walls, apertures and moisture barrier means as claimed by the applicant. The subcombination has separate utility such as a junction box for above-surface communications networking applications.

5. Inventions of Group I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions including the method for installing a subsurface fiber optic cable within a substrate and the method for installing a subsurface fiber optic cable within a soil substrate are not disclosed as being used together and they have different modes of operation in that one method may be used for installing cable above-ground in concrete or building material, not necessarily in a soil subsurface.

6. Inventions of Group I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions including the method for installing a subsurface fiber optic cable and the fiber optic protector are not disclosed as being used together and they have different effects in that the fiber optic protector may be used for above-surface installation of cable.

7. Inventions of Group I and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for

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using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fiber optic cable network can be used for above-surface installation of a fiber optic cable system.

8. Inventions of Group I and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the fiber optic cable network can be installed in a channel greater than 50mm.

9. Inventions of Group II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the cable winder does not require fiber optic cable with moisture absorbent member. The subcombination has separate utility such as when the fiber optic cable is used for straight runs of the cable in an installation, not where cable is wound then installed.

10. Inventions of Group II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

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does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the junction box does not require a cable winder for the cable junction. The subcombination has separate utility such as a cable winder for basic cable storage.

11. Inventions of Groups II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of the cable winder and method of installing subsurface fiber optic cable are not disclosed as being used together and they have different functions in that the winder stores extra lengths of cable by winding the cable about a point and the method provides a trench with cable disposed in a box provided in the trench.

12. Inventions of Groups II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention the cable winder has separate utility such as a winder for basic cable storage other than fiber optic cable. See MPEP § 806.05(d).

13. Inventions of Groups II and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the cable winder has separate

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utility such as a winder for basic cable storage other than fiber optic cable. See MPEP § 806.05(d).

14. Inventions of Groups II and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the cable winder has separate utility such as a winder for basic cable storage other than fiber optic cable. See MPEP § 806.05(d).

15. Inventions of Groups III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the fiber optic cable has separate utility such as cable not installed with a junction box. Furthermore, the junction box need not be used with fiber optic cable, but any type of cable. See MPEP § 806.05(d).

16. Inventions of Groups III and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method does not require fiber optic cable with a moisture absorbent

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member. The subcombination has separate utility such as fiber optic cable for above-surface installations.

17. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the fiber optic cable with moisture absorbent member has separate utility such as cable installed in above ground installations without need for protection required for subsurface burial applications. See MPEP § 806.05(d).

18. Inventions of Groups III and VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the fiber optic cable with moisture protection does not require being installed in loops of a greater amount than needed for the system connection. The subcombination has separate utility such as looped cable where a moisture absorbent member is not required.

19. Inventions of Groups III and VIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the

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instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the fiber optic cable with moisture protection does not require being installed with nodes comprising loops and junction boxes. The subcombination has separate utility such as that the fiber optic cable network with nodes may be installed in above-surface installations where specific moisture protection may not be sought.

20. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of a junction box and a method of installing a subsurface fiber optic cable system are not disclosed as being used together and the junction box has a different effect of forming a cable junction as opposed to the method claimed by the applicant in claim 47.

21. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention the junction box has separate utility such as a box for forming a junction for cable other than fiber optic cable in subsurface conditions. See MPEP § 806.05(d).

22. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention of the junction box has separate utility such as a box for forming a junction for cable other than fiber optic cable. See MPEP § 806.05(d).

23. Inventions IV and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the junction box has separate utility such as a box for forming a junction for cable other than fiber optic cable. See MPEP § 806.05(d).

24. Inventions V and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method does not require a fiber optic protector for retaining cables in stacked array. The subcombination has separate utility such as installed in a subsurface installation wherein the surface is not a soil substrate.

25. Inventions V and VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because the method does not require installation of fiber optic cable in loops greater than the amount necessary for connection to a network. The subcombination has separate utility such as installation for an above surface fiber optic cable network.

26. Inventions V and VIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method does not require cable loops and junction boxes. The subcombination has separate utility such as a portion of fiber optic cable network in an above surface installation.

27. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the fiber optic protector has separate utility such as a protector in a network that does not use loops of the amount greater than needed for connection. See MPEP § 806.05(d).

28. Inventions VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the fiber optic protector has separate utility

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such as installation in a basic network not comprising junction boxes and cable loops. See MPEP § 806.05(d).

29. Inventions VII and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of the portion of the fiber optic cable network has separate utility such as a network that does not use loops of cable including an amount greater than the amount needed to connect the network. See MPEP § 806.05(d).

30. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

31. A telephone call was made to Dawn Wolff on July 3, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa M. Saldano whose telephone number is 703-605-1167. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on 703-308-2978. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

lms
July 18, 2003



**HEATHER SHACKELFORD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**